UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,900	12/16/2005	Naoki Arai	21581-00479-US	1672

30678 7590 11/02/2009

CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

EXAMINER	
EBRAHIM, NABILA G	

ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
11/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/560,900	ARAI ET AL.	
	Examiner	Art Unit	
	NABILA G. EBRAHIM	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/17/2009, 08/18/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The receipt of Information Disclosure Statements dated 06/17/2009 and 08/18/2006 is acknowledged.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-9, 11-12, 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-239176 (JP '176), the reference' abstract is provided by applicant in the Information disclosure Statement. A machine translation will be attached to this Office Action.

JP '176 teaches a preparation having high stability including a polyhydric alcohol fatty acid ester, a hydrophobic Glycyrrhizae Radix extract and oil and fat. The composition contains glabridin, glabrene, or the like, as main ingredient. Further, it comprises 10-15 wt% of the polyhydric alcohol fatty acid ester diglycerol monofatty acid ester, 1-20 wt% of Glycyrrhizae glabra extract and the balance of oil and fat. It is the position of the Examiner that this balance reads on the amount recited in instant claim 6 of 50% or more of the medium-chain fatty

acid triglyceride. The oil and fat comprises a medium-chain fatty acid [0006]. The composition can be prepared into a cosmetic [0009], or a pharmaceutical preparation [0008].

The recitation of the intent of use of the composition in the claims does not have a patentable weight because the composition of the prior art would be at least capable to perform the same function.

Note also that Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case or either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Therefore, clams 1-6, 8-9, 11-12, 15 and 17 are anticipated by JP'176.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-239176 (JP '176) in view of JP 2003-274856 (JP'856), machine translation is provided.

JP'176 is relied upon for the reasons set forth hereinabove. The reference also teaches that in the invention diglycerol mono- fatty acid ester, such as monoisostearate diglyceryl, is especially preferred [0012]. The disclosure reads on the requirement of instant claim 7. It is noted that as long as the molecule has a partial glyceride it reads on that limitation, even if it is a diglycerol compound.

JP'176 did not teach the food or drink preparation containing the glabridin composition.

JP '856 teaches Oil and fat composition containing hydrophobic extract of licorice. The edible oil and fat composition is obtained by dissolving the hydrophobic extract of licorice in a diglyceride mixture and is used in an oil and fat-using food. Preferably an extract from Glycyrrhiza glabra is used as the hydrophobic extract of licorice. The content of the hydrophobic extract of licorice in the edible oil and fat composition is greater than or equal 0.5 wt.% based on 100 wt.% of the edible oil and fat composition and further preferably the amount of diglyceride in the diglyceride mixture is greater than or equal to 20 wt.%. The fatty acid contains 8-24 carbon atoms and is chosen in view of the need of the oil and fat composition [0010].

The recitation of the intent of use of the composition in the claims does not have a patentable weight because the composition of the prior art would be at least capable to perform the same function.

Note also that Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case or either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

It would have been obvious to a person having ordinary skill in the art at the time the claimed invention was made to make oil and fat composition

comprising glabridin in a food and oil composition in a food since JP'856 teaches that the composition is stable and readily handleable.

Claims 13, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-239176 (JP '176) in view of PCT/JP01/10869 (WO 0247699). As a translation for the PCT, Mae et al. US 20040028751 will be used in the Office Action (Mae).

JP'176 is relied upon for the reasons set forth hereinabove.

JP'176 did not disclose the soft capsule required.

Mae teaches a soft capsule containing licorice hydrophobic extract [0081] for ameliorating multiple risk factor syndrome involving visceral fat-type obesity, diabetes mellitus, hyperlipemia and hypertension [abstract, 0081, 0082]. The composition comprises fat and oil.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to prepare a soft capsule containing licorice hydrophobic extract since it was known that it was successfully made previously in the art and because soft capsules have an aesthetic appearance and are easy to swallow. The person having ordinary skill in the art would expect success in making a food or soft capsule containing Glycyrrhizae glabra extract to reduce the risk or improve the multiple risk factor syndrome involving visceral fat-type obesity, diabetes mellitus and hyperlipemia.

Claim Objection

Claim 14 is objected to because of the following informalities: the claim recites "in an total amount". Appropriate correction is required.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NABILA G. EBRAHIM whose telephone number is (571)272-8151. The examiner can normally be reached on 9:00AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NABILA G EBRAHIM/
Examiner, Art Unit 1618

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618